

## **REMARKS**

### **I. ELECTION/RESTRICTION**

Claims 1-13 are currently pending. Claim 13 is currently amended. Claims 8-11 have been withdrawn as being directed to a non-elected species.

### **II. RESTRICTION REQUIREMENT**

The Examiner has issued a restriction requirement stating that the application claims sixteen distinct inventions. Specifically, the Examiner identified the sixteen inventions as being:

- I      Claims 1-7, 12, drawn to a polypeptide dimer comprising two soluble gp130 molecules.
- II     Claims 8-11, drawn to a nucleic acid encoding a polypeptide dimer comprising two soluble gp130 molecules, a vector, a host cell, and a process for producing the polypeptide.
- III    Claims 13, drawn to a method of treatment of bone resorption by administering a polypeptide dimer comprising two soluble gp 130 molecules.
- IV    Claim 13, drawn to a method of treatment of hypercalcemia by administering a polypeptide dimer comprising two soluble gp130 molecules.
- V     Claim 13, drawn to a method of treatment of cachexia by administering a polypeptide dimer comprising two soluble gp130 molecules.
- VI    Claim 13, drawn to a method of treatment of a tumor by administering a polypeptide dimer comprising two soluble gp130 molecules.
- VII   Claim 13, drawn to a method of treatment of an autoimmune disease by administering a polypeptide dimer comprising two soluble gp130 molecules.
- VIII   Claim 13, drawn to a method of treatment of an inflammatory disease by administering a polypeptide dimer comprising two soluble gp130 molecules.

- IX Claim 13, drawn to a method of treatment of a bacterial or viral infection by administering a polypeptide dimer comprising two soluble gp130 molecules.
- X Claim 13, drawn to a method of prevention of bone resorption by administering a polypeptide dimer comprising two soluble gp130 molecules.
- XI Claim 13, drawn to a method of prevention of hypercalcemia by administering a polypeptide dimer comprising two soluble gp130 molecules.
- XII Claim 13, drawn to a method of prevention of cachexia by administering a polypeptide dimer comprising two soluble gp130 molecules.
- XIII Claim 13, drawn to a method of prevention of a tumor by administering a polypeptide dimer comprising two soluble gp130 molecules.
- XIV Claim 13, drawn to a method of prevention of an autoimmune disease by administering a polypeptide dimer comprising two soluble gp130 molecules.
- XV Claim 13, drawn to a method of prevention of an inflammatory disease by administering a polypeptide dimer comprising two soluble gp130 molecules.
- XVI Claim 13, drawn to a method of prevention of a bacterial or viral infection by administering a polypeptide dimer comprising two soluble gp130 molecules.

Applicants elect **GROUP I**, Claims 1-7, 12, drawn to a polypeptide dimer comprising two soluble gp130 molecules, with traverse. Applicants reserve the right pursuant to 35 U.S.C. §121 to file one or more divisional applications directed to the non-elected inventions during the pendency of the present application.

Applicants note that 35 U.S.C. §121 states that “[i]f two or more independent and distinct inventions are claimed in one application, the Director may require the application to be restricted to one of the inventions” (emphasis supplied). Guidance to the interpretation of the terms “independent” and “distinct” is provided in MPEP 802.01. Independent is explained to mean that

there is no disclosed relationship between two or more inventions and they are unconnected in design, operation and effect. MPEP 802.01 I. “Two or more inventions are related (i.e., not independent) if they are disclosed as connected in at least one design (e.g., structure or method of manufacture), operation (e.g., function or method of use), or effect.” MPEP 802.01 II (emphasis supplied).

Applicants respectfully assert that claim 13 as amended discloses a method of use for polypeptide dimers comprising two soluble gp130 molecules. Therefore, all 14 allegedly distinct inventions of claim 13 are closely related and are not independent and distinct. Consequently, a restriction requirement is improper, and hence, Applicants respectfully ask that the restriction requirement be withdrawn.

Further guidance on the proper requirement for restriction between patentably distinct inventions requires that the search be a “serious burden” on the examiner if restriction is not required. MPEP 803 I.

Applicants respectfully contend that polypeptide dimers comprising two soluble gp130 molecules comprise a specific class of molecules. Any search query with terms that encompass this class of molecules will limit the results of any search, including any search regarding the use of these compounds for treatment or prevention of conditions. Therefore, the search results will be highly limited and co-extensive. Hence, Applicants respectfully submit that it would not be unduly burdensome for Examiner to search the method of use of polypeptide dimers comprising two soluble gp130 molecules in the treatment or prevention of conditions.

The criteria for the proper requirement of the restriction of between inventions clearly states that two requirements must be met. First, “inventions must be independent” and second, “[t]here would be a serious burden on the examiner if restriction is not required.” MPEP 803 I. Applicants assert that neither of these requirements is met and therefore a restriction requirement is improper. Hence, Applicants respectfully request the withdrawal of the restriction requirement.

**III. REJOINDER UNDER IN RE OCHIAL, IN RE BROUWER**

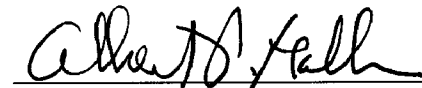
As noted in the office action dated March 26, 2008, which specified restriction requirements, "Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that *depend from or otherwise include all the limitations* of the allowable product claim will be rejoined in accordance with the provisions of MPEP §821.04" (emphasis added). Accordingly, Applicants note that on an indication of allowance of the elected product claims, the corresponding process claims will be rejoined.

**FEE AUTHORIZATION**

The Commissioner is authorized to charge any additional fees which may be required, including petition fees and extension of time fees, to Deposit Account No. **23-2415** (Docket No. 31304-763.831).

Respectfully submitted,

By:



Albert P. Halluin

Registration No. 25,227

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**WILSON SONSINI GOODRICH & ROSATI**  
650 Page Mill Road  
Palo Alto, CA 94304-1050  
Direct Dial: (650) 565-3585  
**Customer No. 21971**